

REMARKS

Reconsideration is respectfully requested in light of the foregoing Amendment and remarks that follow.

Claims 65-153 are pending in the application, with claims 65, 90, 115, and 140 being the independent claims. Claims 65-153 are added. Claims 1-64 are cancelled. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Payment of Claim Fees Incurred by Examiner's Amendment

Applicant thanks the Examiner both for the Examiner's Amendment and for pointing out the requisite fees. With this submission, applicant respectfully submits the requisite fees for the additional 25 claims and additional 2 independent claims, which includes the 1 claim and 2 independent claim fees noted in the Office Action. If the Office determines that additional fees are required, then such fees are hereby authorized, as noted above, to be charged to our Deposit Account No. 22-0261. In the event of such charges, please advise us accordingly.

Entry of the Preliminary Amendment

Applicant respectfully requests the Examiner's assistance, if he has not already done so, in obtaining entry of the Preliminary Amendment, filed on September 21, 2001. The amendment was submitted concurrently with a Petition, which was subsequently dismissed as moot, as the time limit provisions of 37 C.F.R. §1.78 do not apply in the present case, and no petition was required.

Applicant respectfully submits a Supplemental Declaration, which reflects the priority claim, as submitted in the Preliminary Amendment, and executed by all of the inventors.

Entry of both the Preliminary Amendment, as being filed on September 21, 2001, and Supplemental Declaration is respectfully requested.

Rejections under 35 U.S.C. §103(a)

The Office Action represented two obviousness rejections in the non-final Office Action, Paper No. 7, mailed on September 17, 2003:

1. Claims 1-7, 15-23, 31-37, 45-51, 59-62, and 64 are rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 6,036,601 issued to Heckel in view of Avaterra.com via Web Archive (hereinafter "Avaterra"). See Office Action at ¶ 6.

2. Claims 8-14, 24-30, 38-44, 52-58, and 63 are rejected under 35 U.S.C. §103(a) as being unpatentable over Heckel in view Avaterra, and further in view of US P.G. Pub. No. US 2001/0034661 issued to Ferriera. See Office Action at ¶ 39.

Applicant respectfully submits that these restated rejections have been rendered moot or are accommodated by the above-entered amendments.

In addition, as the newly added claims are submitted only to clarify the claimed invention, and not in response to the applied or cited references, applicant respectfully traverses these rejections in the follow discussion.

Applicant respectfully submits that the Office Action has not provided a prima facie case for obviousness in these two combinations. The following arguments first discuss the defects of the above-cited references, and second discuss defects in each of the obviousness rejections.

There are technical differences between Heckel and the claimed invention which are now described. Heckel appears to teach a method for advertising in a virtual environment, such as a video game, where advertisements are displayed at appropriate locations in a virtual scene, such as a billboard. Heckel also appears to teach the tracking of a player's exposure to advertisements based upon the appearance of a player in a location with the advertisements displayed.

Applicant agrees, however, that Heckel fails to teach providing a selection of one or more advertisements by a participant, and providing a selection of one or more locations for the display of the one or more advertisements in a virtual world by a participant. Furthermore, Heckel fails to teach receiving a participant's selection, creating ad content from the selection, and forwarding the ad content to the virtual world. See new claims 65, 83, 101, and 119, which clarify the selection and display process of now cancelled claims 1, 31, and 45.

In contrast with Heckel, the claimed invention includes a dynamic process where a participant chooses, in large part, the location and content of the advertisements that are displayed to other participants. See pgs. 8-10 of the Specification.

With respect to Avaterra, the web archive appears to provide for a method by which users may construct representations of themselves in a virtual environment. Specifically, Avaterra appears to teach that these representations or avatars may be 'body sprayed' to simulate clothing so as to present a more realistic appearance. See FAQ at page 3 of provided archives.

Avaterra fails, however, to teach or suggest any form of advertising by the participants. Furthermore, Avaterra fails to teach or suggest that participants personalize their avatars with anything other than provided 'body sprays' and accessories.

As these features of the independent claims are neither taught nor suggested by either Heckel or Avaterra, neither reference can provide for the respective features of the dependent claims.

In light of these distinctions between the claimed invention and Heckel and Avaterra, the obviousness rejection combining the teachings of Heckel and Avaterra is now addressed. The Office Action states that Avaterra fills a gap in Heckel, where Heckel does not teach explicitly the steps of enabling at least one participant in said virtual world to select an advertisement. See Office Action, ¶ 8.

Avaterra appears to be directed to a virtual environment where users are represented by avatars. Avaterra makes mention of being able to clothe and accessorize avatars. See FAQ of Avaterra at pg. 3 of Web Archive. Avaterra does not teach or describe enabling a participant to select an advertisement. Applicant respectfully submits that the Avaterra fails to teach the gap in Heckel, and that the combination of Heckel and Avaterra fail to teach all of the elements of the claimed invention. Thus, the Office Action fails to present a prima facie case of obviousness.

Furthermore, applicant does not consider the selection of clothing and accessories of Avaterra to provide any inherent teaching of selecting an advertisement. In this respect, applicant respectfully reminds the Office that “inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.” See *In re Spormann*, 363 F.2d 444 (1966). Similarly, the ordinary skill in the art does not operate to supply missing knowledge to reach a state of obviousness. See *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540 (1984). Thus, skill in the art may not act as a bridge over gaps in substantive presentation of an obviousness case. See *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714 (Fed. Cir. 1991).

In addition, applicant respectfully submits that there is no motivation to combine Heckel and Avaterra. Avaterra provides no teaching or suggestion of advertising or advertisements. Thus, one would not be motivated to combine the teachings of Avaterra with the teachings of Heckel.

With respect to the rejection of the claims with the combination of Heckel and Avaterra further in view of Ferreira, applicant respectfully traverses this rejection in light of the above-stated distinctions.

For at least the above reasons, applicant respectfully submits that claims 65-132 are believed to be patentable over the applied combinations. Furthermore, the claims depending from the independent claims are believed to be allowable for at least the reasons described

above, and further in view of their own respective features. Withdrawal of the rejection is respectfully requested.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all currently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

March 17, 2004
Date

Respectfully submitted,

Walter R. Swindell
Walter R. Swindell
(Registration No. 50,906)

VENABLE LLP
Post Office Box 34385
Washington, DC 20043-9998
Telephone: (202) 962-4800
Direct dial: 202-344-4053
Telefax : (202) 962-8300

DC2-DOCS1-531730